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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/902,767	07/12/2001	Robert Noodelijk	CHRE:110	9584

7590 12/02/2005

CHARLES A WENDEL
STEPTOE & JOHNSON LLP
1330 CONNECTICUT AVENUE NW
WASHINGTON, DC 20036

EXAMINER

HWU, JUNE

ART UNIT	PAPER NUMBER
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1661

DATE MAILED: 12/02/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.		Applicant(s)	
	09/902,767		NOODELIJK, ROBERT	
	Examiner		Art Unit	
	June Hwu		1661	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

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DETAILED ACTION

In view of the Remand from the Board of Patent Appeals and Interferences dated May 16, 2005 and the subsequent request for information filed on July 14, 2005, PROSECUTION IS HEREBY REOPENED. A new ground of rejection is set forth below.

To avoid abandonment of the application, appellant must exercise one of the following two options:

(1) file a reply under 37 CFR 1.111 (if this Office action is non-final) or a reply under 37 CFR 1.113 (if this Office action is final); or,

(2) initiate a new appeal by filing a notice of appeal under 37 CFR 41.31 followed by an appeal brief under 37 CFR 41.37. The previously paid notice of appeal fee and appeal brief fee can be applied to the new appeal. If, however, the appeal fees set forth in 37 CFR 41.20 have been increased since they were previously paid, then appellant must pay the difference between the increased fees and the amount previously paid.

A Supervisory Patent Examiner (SPE) has approved of reopening prosecution by signing below:

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claim 1 is rejected under 35 U.S.C. 102(b) as being anticipated by the Netherlands Plant Breeder's Right (PBR) application number CHR2752 published on May 16, 1996, more than one year prior to the effective filing date of this instant plant application in view of Applicant's

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admission that the instant cultivar was first sold in the Netherlands on December 1998 (response dated December 10, 2002, page 3), and in light of the Plant Varieties Journal Quarter One 2004, Vol. 17, No. 1, page 303 which indicates the instant cultivar was first sold in the Netherlands on January 15, 1998, and in light of The New Royal Horticultural Society Dictionary of Gardening 1992 vol. 1 that describe the asexual reproduction of chrysanthemum (pages 614-618).

Claim 1 is rejected under 35 U.S.C. 102(b) as being anticipated by the European Plant Breeder's Right (PBR) application number 19970499 published on June 15, 1997, more than one year prior to the effective filing date of this instant plant application in view of Applicant's admission that the instant cultivar was first sold in the Netherlands on December 1998 (response dated December 10, 2002, page 3), and in light of the Plant Varieties Journal Quarter One 2004, Vol. 17, No. 1, page 303 which indicates the instant cultivar was first sold in the Netherlands on January 15, 1998, and in light of The New Royal Horticultural Society Dictionary of Gardening 1992 vol. 1 that describe the asexual reproduction of chrysanthemum (pages 614-618).

Claim 1 is rejected under 35 U.S.C. 102(b) as being anticipated by the Polish Plant Breeder's Right (PBR) application number OO00536 published on March 31, 1999, more than one year prior to the effective filing date of this instant plant application in view of Applicant's admission that the instant cultivar was first sold in the Netherlands on December 1998 (response dated December 10, 2002, page 3), and in light of the Plant Varieties Journal Quarter One 2004, Vol. 17, No. 1, page 303 which indicates the instant cultivar was first sold in the Netherlands on January 15, 1998, and in light of The New Royal Horticultural Society Dictionary of Gardening 1992 vol. 1 that describe the asexual reproduction of chrysanthemum (pages 614-618).

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The publications cited above disclose the claimed variety. There is evidence to show that the instant cultivar was accessible to the public and was described in a printed publication, more than one year prior to the effective filing date of this instant plant application. For example, as discussed above the instant cultivar was described in the PBR applications and Applicant's admission that the instant cultivar was available to the public as early as December 1998 and in light of the Plant Varieties Journal Quarter One 2004 disclosing that the instant cultivar was first sold in The Netherlands on January 15, 1999 (page 303), more than one year prior to the effective filing date of this instant plant application. The foreign sale must not be an obscure, solitary occurrence that would go unnoticed by those skilled in the art. One of ordinary skill in the art would have known where to obtain the claimed plant because PBR applications disclose the applicant, Chrysanthemum Breeder' Association (CBA) N.V. For example, by searching the Internet for Chrysanthemum Breeder' Association N.V., a person of ordinary skill could check the availability of the instant cultivar by contacting CBA by e-mail, phone, fax number or mail at website <www.cba-nv.nl>. With regard to the reproducibility of the instant cultivar, a person skilled in the art would have the knowledge of reproducing the instant cultivar, given the notoriety of various methods of asexual propagation of a chrysanthemum as shown by RHS Dictionary of Gardening reference (pages 614-618).

A printed publication can serve as a statutory bar under 35 U.S.C. 102(b) if the reference, combined with knowledge in the prior art, would enable one of ordinary skill in the art to reproduce the claimed plant. *In re Le Grice*, 301 F.2d 929, 133 USPQ 365 (CCPA 1962). If one skilled in the art could obtain or reproduce the plant from a publicly available source, then a publication describing the plant would have an enabling disclosure. See *Ex parte Thomson*, 24 USPQ2d 1618, 1620 (Bd. Pat. App. & Inter. 1992) ("The issue is not whether the [claimed] cultivar Siokra was on public use or sale in the United States but, rather, whether 'Siokra' seeds

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were available to a skilled artisan anywhere in the world such that he/she could attain them and make/reproduce the cultivar Siokra disclosed in the cited publications.”). Moreover, the Court in *In re Elsner*, 72 USPQ2d 1038 (CA FC 2004) states that a printed publication coupled with a foreign sale of the plant would constitute a bar under §102(b) on page 1040.

Response to Arguments

Applicant argues that the CBA catalog distributed on November 1998 describes ‘Reagan Elite White’ and the instant plant application is ‘White Elite Reagan’ is not a statutory disclosure of the invention (response dated July 14, 2005 on page 1).

This argument is not persuasive because 35 USC § 102(b) states that “A person shall be entitled to a patent unless - ... (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of the application for patent in the United States ...” The rejection is based upon the instant cultivar described in the printed publication such as a catalog more than one year prior to the effective filing date of the instant application and the availability of the plant anywhere in the world as evidence by the Plant Varieties Journal Quarter One 2004 and applicant’s admission of the sale as early as December 1998 in the Netherlands. The Court in *In re Elsner* 72 USPQ2d 1038 (CA FC 2004) states on page 1041, “When a publication identifies the plant that is invented or discovered and a foreign sale occurs that puts one of ordinary skill in the art in possession of the plant itself, which, based on the level of ordinary skill in the art, permits asexual reproduction without undue experimentation, that combination of facts and events so directly conveys the essential knowledge of the invention that the sale combines with the publication to erect a statutory bar.” Thus, the publication with the sale of the instant cultivar

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more than one year prior to the effective filing date of the instant application would constitute a bar under 35 U.S.C. 102(b).

Applicant argues that a person skilled in the art would need to know the parentage of the plant to practice the invention (response page 2).

This argument is not persuasive because that is not the issue in this case. The issue is the printed PBR published more than one year prior to the effective filing date of the present application and the availability of the instant cultivar anywhere in the world in which a person skilled in the art would have been able to asexually reproduce the plant.

Applicant argues that the 102(b) rejection is in violation with the UPOV Convention (response page 2).

This argument has been carefully considered, however, it is not persuasive because according to Article 35(2)(a) of the text, which states the following:

Notwithstanding the provisions of Article 3(1), any State which, at the time of becoming party to this Convention, is a party to the Act of 1978 and which, as far as varieties reproduced asexually are concerned, provides for protection by an industrial property title other than a breeder's right shall have the right to continue to do so without applying this Convention to those varieties.

The MPEP 1612 states the following:

Application of the UPOV Convention in the United States does not affect the examination of plant patent applications, except in one instance. It is now necessary as a condition for receiving a plant patent to register a variety denomination for that plant. Inclusion of the variety denomination in the patent comprises its registration.

As a result, this rejection does not violate the UPOV Convention because Article 35(2)(a) allows the U.S. Patent and Trademark Office to continue practice established in 1930 with the Plant Patent Act.

Conclusion

No claim is allowed.

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Future Correspondence

Any inquiry concerning this communication or earlier communications from the examiner should be directed to June Hwu whose telephone number is (571) 272-0977. The Examiner can normally be reached Monday through Thursday from 6:30 a.m. to 5:00 p.m.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Anne Marie Grunberg, can be reached on (571) 272-0975. The fax number for the organization where this application or proceeding is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

JH


ANNE MARIE GRUNBERG
Supervisory PRIMARY EXAMINER